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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,050

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EXAMINER

KOLLIAS, ALEXANDER C

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,050	Applicant(s) KIM ET AL.	
	Examiner ALEXANDER C. KOLLIAS	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060622</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The use of the trademark KEPITAL F25-03H has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-2, 4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuuchi et al (US 5,212,222).

Regarding claims 1-2, 4, and 7, Mitsuuchi et al teaches a polyacetal composition comprising polyoxymethylene polymer and a stabilizer system comprising at hindered phenols such as triethylene glycol bis-[3-3-tert-butyl-5-methyl-4-hydroxyphen)-propionate (an antioxidant), metal containing organic acid salt such as magnesium stearate, and nitrogen containing compounds such as melamine (Abstract, Column 4, Lines 9-17, Column 5, Lines 45-57, and Column 6, Lines 32-57). The reference discloses that the composition comprises additives such as inorganic or organic fibrous, particulate or flaky fillers (Column 7, Lines 1-9). Additionally, the reference discloses shaped articles produced from the disclosed polyacetal composition (Column 1, Lines 21-30 and Lines 57-60 and Column 7, Lines 10-19).

The disclosed amounts of these organic acid salt and melamine stabilizers are 0.01 to 5 parts by weight per 100 parts of the polyacetal resin (Column 6, Lines 58-62). When the amount of these stabilizers is less than 0.01 parts by weight little if any improvement in heat stability can be attained (Column 6, Lines 14-17). However, if the amount of stabilizer exceeds 5 parts by weight, deposits of the first stabilizer component are likely to form on the surface of the composition and one molded articles (Column 6, Lines 17-21).

Regarding the amount of phenolic anti-oxidant the reference discloses that the amount is from 0.01 to 5 parts by weight per 100 parts of the polyacetal resin (Column 6, Lines 58-62). If

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the amount of this stabilizer is excessively small, little, if any, beneficial effects can be attained (Column 6, Lines 62-64). However, if the stabilizer is present in excessive amount, no further improvement in heat stability can be attained and unfavorable phenomena such as stabilizer bleeding occurs (Column 6, Lines 64-68).

Given that Mitsuuchi et al discloses a polyacetal resin composition comprising magnesium stearate, antioxidant, and thermal stabilizers, it would have been obvious to one of ordinary skill in the art at the invention was made to have selected amounts of the stabilizers disclosed by the reference as it is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

6. Claims 3, 5-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuuchi et al (US 5,212,222) as applied to claims 1-2, 4 and 7 above and in view of Anada (5,777,019).

Regarding claims 3, 5-6, and 8, Mitsuuchi et al teaches all the claim limitations as set forth above. However, the reference does not explicitly disclose that the reinforcing filler comprising 50 parts by weight or less.

Anada discloses a composition comprising a polyacetal resin and a glass type inorganic filler such as glass fiber or flake that are added to the composition in the amounts of 3 to 200

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parts by weight (Abstract, Column 1, Lines 42-43 and Column 2, Lines 1-6). The reference discloses that amounts less than 3 parts by weight of filler insufficiently improve the mechanical properties of the composition, while amount greater 200 parts by weight makes molding difficult (Column 2, Lines 49-55).

Given that both Mitsuuchi et al and Anada are drawn to compositions comprising polyacetal resins and fillers, and, given that Mitsuuchi et al does not explicitly prohibit other ingredients, in light of the particular advantages provided by the use and control of the amount of glass filler as taught by Anada, it would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition disclosed by Mitsuuchi et al to include amounts of the glass filler as taught by Anada with a reasonable expectation of success.

7. Claims 1-2, 4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al (KR 10-2003-0048733, see attached pages for translation).

Regarding claims 1-2, 4, and 7, Lim et al discloses a composition comprising a polyacetal resin, 0.01 to 5 parts by weight of an antioxidant, 0.01 to 2 parts by weight of a formaldehyde reactive material (thermal stabilizers) such as melamine, and 0.05 to 4 parts by weight of an acid salt compounds such as magnesium stearate. (Abstract, Page 3, Paragraph 14 and Page 4 Paragraphs 1-6). The reference discloses that is the amount of formaldehyde stabilizer is greater than 2 parts by weight the reactive material is segregated at the surface of the molded article and therefore becomes unusable (Page 5, Paragraph 7). Additionally, the reference discloses that the

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composition is used to produce shaped articles such as water-pipe, and water tanks and items for which chlorine resistance is required (Page 5 Paragraph 5, 7-8).

Given that Lim et al discloses a polyacetal resin composition comprising magnesium stearate, antioxidant, and thermal stabilizers, it would have been obvious to one of ordinary skill in the art at the invention was made to have selected amounts of the stabilizers disclosed by the reference as it is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

8. Claims 3, 5-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al (KR 10-2003-0048733, see attached pages for translation) as applied to claims 1-2, 4 and 7 above and in view of Anada (5,777,019).

Regarding claims 3, 5-6, and 8 Lim et al teaches all the claim limitations as set forth above. However, the reference does not disclose that a polyacetal composition comprising filler an amount of less than 50 parts by weight.

Anada discloses a composition comprising a polyacetal resin and a glass type inorganic filler such as glass fiber or flake that are added to the composition in the amounts of 3 to 200 parts by weight (Abstract, Column 1, Lines 42-43 and Column 2, Lines 1-6). The reference discloses that amounts less than 3 parts by weight of filler insufficiently improve the mechanical

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properties of the composition, while amount greater 200 parts by weight makes molding difficult (Column 2, Lines 49-55).

Given that both Lim et al and Anada are drawn to compositions comprising polyacetal resins, and, given that Lim et al does not explicitly prohibit other ingredients, in light of the particular advantages provided by the use and control of the amount of glass filler as taught by Anada, it would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition disclosed by Lim et al to include amounts of the glass filler as taught by Anada with a reasonable expectation of success.

9. Claims 1-2, 4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al (US 5,191,006).

Regarding claims 1-2, 4, and 7, Matsumoto et al discloses a composition comprising a polyacetal resin, of 0.01 to 2.0 parts by weight magnesium stearate, 0.05 to 3.0 parts by weight of an anti-oxidant such as triethylene glycol bis-[3-3-tert-butyl-5-methyl-4-hydroxyphen)-propionate, and 0.01 to 7 parts by weight of a formaldehyde catcher such as melamine (Abstract, Column 3, Lines 19-30, column 4, Lines 37-45, and Column 5, Lines 1-17 and Lines 27-37). Additionally, the reference discloses that the composition may comprise fillers or reinforcing material such as carbon and glass fibers (Column 4, Lines 62-69)

Regarding the amounts of anti-oxidant and formaldehyde, the reference discloses that when the amount is less than 0.01 no affect of the compounds is attained in the composition, while then the amount is greater than 7 arts by weight, the appearance of the molded article

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formed by continuous injection molding is undesirably deteriorated (Column 5, Lines 19-26 and Column 38-43).

Regarding the amount of metal salt, the reference discloses that if the amount is not within the range of 0.01 to 2.0 the following defects occur; deterioration in appearance of a molded article such as defective color tone and silver streaks, dimensional failure due to replication of a mold contamination substance such as a mold deposit on a molded article, and surface roughening (Column 4, Lines 56-61).

Given that Matsumoto et al discloses a polyacetal resin composition comprising magnesium stearate, antioxidant, and thermal stabilizers, it would have been obvious to one of ordinary skill in the art at the invention was made to have selected amounts of the stabilizers disclosed by the reference as it is well settled that where the prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See *In re Harris*, 409 F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 2d 1379, 1382 (Fed. Cir. 1997); *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

10. Claims 3, 5-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al (US 5,191,006) as applied to claims 1-2, 4 and 7 above and in view of Anada (5,777,019).

Regarding claims 2, 5-6, and 8, Matsumoto et al discloses all the claim limitations as set forth above. Additionally, the reference discloses that fillers can be added to the composition as

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required in amounts that the effects of the composition are not impaired (Column 4, Lines 62-69). However, the reference does not explicitly disclose that the composition comprises less than 50 parts by weight of a reinforcing agent.

Anada discloses a composition comprising a polyacetal resin and a glass type inorganic filler such as glass fiber or flake that are added to the composition in the amounts of 3 to 200 parts by weight (Abstract, Column 1, Lines 42-43 and Column 2, Lines 1-6). The reference discloses that amounts less than 3 parts by weight of filler insufficiently improve the mechanical properties of the composition, while amount greater 200 parts by weight makes molding difficult (Column 2, Lines 49-55).

Given that both Matsumoto et al and Anada are drawn to compositions comprising polyacetal resins and fillers, and, given that Mitsuuchi et al does not explicitly prohibit other ingredients, in light of the particular advantages provided by the use and control of the amount of glass filler as taught by Anada, it would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition disclosed by Matsumoto et al to include amounts of the glass filler as taught by Anada with a reasonable expectation of success.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Three obviousness-type double patenting rejections are set forth below

Double Patenting: I

12. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-2, 4-6, and 17-18 of copending Application No. 11/664,705 in view of Matsumoto et al (US 5,191,006).

Claims 1, 2, 5-6, and 10-14 of copending Application No. 11/664,705 recite 100 parts by weight of a polyacetal resin, 0.005 to 2 parts by weight melamine, and 0.01 to 3 parts by weight of triethylene glycol bis-[3-3-tert-butyl-5-methyl-4-hydroxyphen)-propionate.

While the claims in both applications are open to the inclusion of additional ingredients (cf. the use of "comprising" in the claims), it is noted that Claims 1-2, 4-6, and 17-18 of copending Application No. 11/664,705 lack such additional ingredients as magnesium stearate and reinforcing fillers.

Matsumoto et al discloses a polyacetal composition comprising antioxidant, thermal stabilizers as well as magnesium stearate and reinforcing fillers (Abstract, Column 3, Lines 19-30, Column 4, Lines 37-45 and Lines 62-69, and Column 5, Lines 1-17 and Lines 27-37). In particular the reference discloses the amounts of magnesium stearate in the range of 0.01 to 2.0 parts by weight (Column 4, Lines 56-61). If the amount is not within the range of 0.01 to 2.0 the

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following defects occur; deterioration in appearance of a molded article such as defective color tone and silver streaks, dimensional failure due to replication of a mold contamination substance such as a mold deposit to a molded article, and surface roughening (Column 4, Lines 56-61).

Given that polyacetal compositions for articles contain anti-oxidants, thermal stabilizers, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of copending U.S. application 11/664,705 to include fillers and magnesium stearate and reinforcing fillers as disclosed by Matsumoto et al and thereby arrive at the presently claimed invention.

13. Claims 1-8 are directed to an invention not patentably distinct from Claims 1-2, 4-6, and 17-18 of commonly assigned copending Application No. 11/664,705. Specifically, see the discussion set forth in paragraph 12 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned copending Application No. 11/664,705, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

This is a provisional obviousness-type double patenting rejection

Double Patenting: II

14. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 4-5 of U.S. Patent No. 7,098,262 in view of Matsumoto et al (US 5,191,006).

U.S. '262 claims a polyacetal composition comprising antioxidant and thermal stabilizers in the amount of 0.01 to 1 parts by weight. Additionally, the claims recited molded articles made from the polyacetal composition

While the claims in US '262 and the instant application are open to the inclusion of additional ingredients (cf. the use of "comprising" in the claims), it is noted that Claims 1 4-5 of US '262 lack such additional ingredients as magnesium stearate and reinforcing fillers.

Matsumoto et al discloses a polyacetal composition comprising antioxidant, thermal stabilizers as well as magnesium stearate and reinforcing fillers (Abstract, Column 3, Lines 19-30, Column 4, Lines 37-45 and Lines 62-69, and Column 5, Lines 1-17 and Lines 27-37). In particular the reference discloses the amounts of magnesium stearate in the range of 0.01 to 2.0 parts by weight (Column 4, Lines 56-61). If the amount is not with the range of 0.01 to 2.0 the

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following defects occur; deterioration in appearance of a molded article such as defective color tone and silver streaks, dimensional failure due to replication of a mold contamination substance such as a mold deposit to a molded article, and surface roughening (Column 4, Lines 56-61).

Given that polyacetal compositions for articles contain anti-oxidants, thermal stabilizers, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of US '262 to include fillers and magnesium stearate and reinforcing fillers as disclosed by Matsumoto et al and thereby arrive at the presently claimed invention.

15. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 7,098,262 in view of Matsumoto et al (US 5,191,006).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C.

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103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). Specifically, see discussion set forth above in Paragraph 14.

16. Claims 1-8 are directed to an invention not patentably distinct from Claims 1 and 4-5 of commonly assigned U.S. patent 7,098,262. Specifically, see the discussion set forth in paragraph 13 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 7,098,262, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Double Patenting: III

17. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 11-12 of U.S. Patent No. 6,512,047 in view of Matsumoto et al (US 5,191,006).

U.S. '047 claims a composition comprising polyoxymethylene resin, an anti-oxidant and a stabilizer. Additionally, the claims recite a shaped articles formed from the composition. While US '047 does not claim a thermal stabilizer note that Column 4 Line 65 recites the stabilizer melamine. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970). Therefore, it would have been obvious to one of ordinary skill in the art

While the claims in US '047 and the instant application are open to the inclusion of additional ingredients (cf. the use of "comprising" in the claims), it is noted that Claims 1 and 11-12 of US '047 lack such additional ingredients as magnesium stearate and reinforcing fillers.

Matsumoto et al discloses a polyacetal composition comprising antioxidant, thermal stabilizers as well as magnesium stearate and reinforcing fillers (Abstract, Column 3, Lines 19-30, Column 4, Lines 37-45 and Lines 62-69, and Column 5, Lines 1-17 and Lines 27-37). In particular the reference discloses the amounts of magnesium stearate in the range of 0.01 to 2.0 parts by weight (Column 4, Lines 56-61). If the amount is not with the range of 0.01 to 2.0 the following defects occur; deterioration in appearance of a molded article such as defective color tone and silver streaks, dimensional failure due to replication of a mold contamination substance such as a mold deposit to a molded article, and surface roughening (Column 4, Lines 56-61).

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Given that polyacetal compositions for articles contain anti-oxidants, thermal stabilizers, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of US '047 to include fillers and magnesium stearate and reinforcing fillers as disclosed by Matsumoto et al and thereby arrive at the presently claimed invention.

18. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,512,047 in view of Matsumoto et al (US 5,191,006).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). Specifically, see discussion set forth above in Paragraph 16.

19. Claims 1-8 are directed to an invention not patentably distinct from Claims 1 and 4-5 of commonly assigned U.S. patent 6,512,047. Specifically, see the discussion set forth in paragraph 16 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 76,512,047, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER C. KOLLIAS whose telephone number is (571)270-3869. The examiner can normally be reached on Monday-Friday, 8:00 AM -5:00 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C. K./

Examiner, Art Unit 1796

/VASUDEVAN S. JAGANNATHAN/

Supervisory Patent Examiner, Art Unit 1796